



AF/3629
IFW

PATENT
Customer No. 22,852
Attorney Docket No. 5725.1009

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
)
Gilles RUBINSTENN et al.) Group Art Unit: 3629
)
Application No.: 10/024,351) Examiner: Borissov, Igor N.
)
Filed: December 21, 2001)
)
For: CUSTOMIZED BEAUTY) Confirmation No.: 4841
TRACKING KIT)

Mail Stop Appeal Brief--Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

TRANSMITTAL OF APPEAL BRIEF (37 C.F.R. 41.37)

Transmitted herewith is the APPEAL BRIEF in this application with respect to the
Notice of Appeal filed on February 22, 2005.

This application is on behalf of

☐ Small Entity ☒ Large Entity

Pursuant to 37 C.F.R. 41.20(b)(2), the fee for filing the Appeal Brief is:

☐ \$250.00 (Small Entity)

☒ \$500.00 (Large Entity)

TOTAL FEE DUE:

Extension Fee (if any) \$1,020.00

Total Fee Due \$500.00

☒ A check for \$1,520.00 is enclosed to cover the above fees.

PETITION FOR EXTENSION. If any extension of time is necessary for the filing of this Appeal Brief, and such extension has not otherwise been requested, such an extension is hereby requested, and the Commissioner is authorized to charge necessary fees for such an extension to our Deposit Account No. 06-0916.

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 22, 2005

By: 

Christopher T. Kent
Reg. No. 48,216



PATENT
Customer No. 22,852
Attorney Docket No. 05725.1009-00000

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Mail Stop Appeal Brief - Patents

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF UNDER BOARD RULE § 41.37

In support of the Notice of Appeal filed February 22, 2005, and pursuant to 37 C.F.R. § 41.37, Appellants submit this Appeal Brief and enclose herewith a check for the fee of \$500.00 required under 37 C.F.R. § 41.20(b)(2). The period for filing this brief has been extended to July 22, 2005, by the accompanying Petition of Extension of Time of three (3) months and appropriate fee payment.

This appeal responds to the final Office Action mailed September 21, 2004 ("Final Office Action"), finally rejecting claims 1-30, which are set forth in attached Appendix A.

If any additional fees are required or if the enclosed payment is insufficient, Appellants request that the required fees be charged to Deposit Account No. 06-0916.



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I. Real Party In Interest

The real party in interest is L'Oréal S.A., the assignee of the entire right, title, and interest in the application, as indicated by assignment duly recorded in the U.S. Patent and Trademark Office, beginning at Real 012942, Frame 0240, on May 29, 2002.

II. Related Appeals and Interferences

There are currently no other appeals or interferences, of which Appellants, Appellants' legal representative, or Assignee are aware, that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. Status Of Claims

Claims 1-30 are pending in this application. Claims 1-30, as set forth in Appendix A, have been finally rejected in the Final Office Action. The rejections applied to claims 1-30 are at issue in this appeal.

IV. Status Of Amendments

In response to the Office Action mailed March 12, 2004, Appellants filed a Reply to Office Action on June 14, 2004, amending claim 26. No amendments under 37 C.F.R. § 1.116 have been filed subsequent or in response to the Final Office Action.

V. Summary Of Claimed Subject Matter

Consistent with the invention, as set forth in independent claim 1, a beauty diagnostic method is provided. The method involves asking a subject (e.g., Figs. 9A, 9B, item 904) personal questions (e.g., Fig. 2: 202, 204, 206) on at least one topic including characteristics of at least one external body condition of the subject. The method may also involve receiving answers to the personal questions (e.g., Fig. 2: 208, 210, 212) and, based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material (e.g., Fig. 6: 602, 604, 606; Fig. 8: 800) for determining quantitative information that would aid in recommending at least one beauty product to the subject. The method may then inform the subject about said at least one customized set of testing material. See, e.g., Appellants' specification: page 5, lines 3-10; page 7, ¶ 026, lines 7-15; page 31, line 19 – page 32, line 11; page 32, line 17 – page 33, line 10; page 33, lines 12 – 16; page 41, line 14 – page 42, line 11; page 45, line 9 – page 46, line 11; page 49, line 4 – page 50, line 13; Fig. 6; and Fig. 7 (items 702, 704, 706, 708).

Consistent with the invention, as set forth in claim 11, a beauty diagnostic system is provided. The system may comprise:¹

means for asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject (see, e.g., page 8, line 3 – page 12, line 3; page 31, line 19 – page 32, line 5; page 34, line 3 – page 35,

¹ As the prosecution record indicates, the Examiner has not invoked 35 U.S.C. § 112, six paragraph, for interpretation of the terms of claim 11 and its dependent claims 12-19. The Examiner appears to have construed the terms and the prior art under the "broadest reasonable interpretation" standard without considering whether the prior art means was equivalent to the corresponding structure, material or acts described in the present specification. Accordingly, the scope of the terms of claims 11-19 should not be necessarily limited under 35 U.S.C. § 112, six paragraph.

line 12; page 47, line 1 – page 49, line 3; Fig. 1, items 102, 104; Fig. 2, items 200, 202, 204, 206, 220; Fig. 7, item 702; Figs. 9A, 9B (items 906, 908, 910, 920));

means for receiving answers to the personal questions (see, e.g., page 8, line 3 – page 12, line 3; page 32, lines 6-11; page 34, line 3 – page 35, line 12; page 47, line 1 – page 49, line 3; Fig. 1, item 104; Fig. 2, items 208, 210, 212, 220; Fig. 7, item 704; Figs. 9A, 9B (items 906, 908, 910, 920));

means for, based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject (see, e.g., page 9, line 20 – page 12, line 3; page 32, lines 6-11; page 32, lines 17 – page 33, line 10; page 33, lines 4-10; page 34, line 3 – page 35, line 12; page 47, line 1 – page 49, line 3; Fig. 6, items 602, 604, 606; Fig. 7, item 706; Fig. 8, item 800; Figs. 9A, 9B (items 906, 908, 910, 920)); and

means for informing the subject about said at least one customized set of testing material (see, e.g., page 9, line 20 – page 12, line 3; page 32, lines 12-16; page 34, line 3 – page 35, line 12; page 47, line 1 – page 49, line 3; Fig. 2, items 200, 220; Figs. 9A, 9B (items 906, 908, 910, 920)).

Consistent with the invention, as set forth in claim 20, a computer program product for performing a beauty diagnostic is provided. The computer program product may comprise computer-readable media having computer-readable code and may comprise computer-readable program code for effecting actions in a computing platform. See, e.g., Appellant's specification: page 5, ¶ 13; Fig. 2 and accompanying text, Fig. 9 (items 906, 910, 920) and accompanying text. The computer program

product comprises program code for asking a subject (e.g., Figs. 9A, 9B, item 904) personal questions (e.g., Fig. 2: 202, 204, 206) on at least one topic including characteristics of at least one external body condition of the subject. The computer program product also comprises program code for receiving answers to the personal questions (e.g., Fig. 2: 208, 210, 212) and program code for, based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material (e.g., Fig. 6: 602, 604, 606; Fig. 8: 800) for determining quantitative information that would aid in recommending at least one beauty product to the subject. The computer program product additionally comprises program code for informing the subject about said at least one customized set of testing material. See, e.g., Appellants' specification: page 5, lines 3-10; page 7, ¶ 026, lines 7-15; page 31, line 19 – page 32, line 11; page 32, line 17 – page 33, line 10; page 33, lines 12 – 16; page 41, line 14 – page 42, line 11; page 45, line 9 – page 46, line 11; page 49, line 4 – page 50, line 13; Fig. 6; and Fig. 7 (items 702, 704, 706, 708).

Consistent with the invention, as set forth in independent claim 24, a beauty diagnostic method is provided. The method involves asking a subject (e.g., Figs. 9A, 9B, item 904) personal questions (e.g., Fig. 2: 202, 204, 206) on at least one topic including characteristics of at least one external body condition of the subject. The method also involves receiving answers to the personal questions (e.g., Fig. 2: 208, 210, 212) and, based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material (e.g., Fig. 6: 602, 604, 606; Fig. 8: 800) for determining quantitative information that would aid in recommending at least one beauty product to the subject. Consistent with independent claim 24, the

subject may be provided with the customized set of testing material. The method may also involve ascertaining the desired quantitative information by collecting data derived from use of the testing material on the subject and, based on the received answers and the ascertained quantitative information, recommending at least one beauty product to the subject. See, e.g., Appellant's specification: page 33, line 11 – page 34, line 2; Fig. 7, items 710, 712. See also, e.g., Appellants' specification: page 5, lines 3-10; page 7, ¶ 026, lines 7-15; page 31, line 19 – page 32, line 11; page 32, line 17 – page 33, line 10; page 33, lines 12 – 16; page 41, line 14 – page 42, line 11; page 45, line 9 – page 46, line 11; page 49, line 4 – page 50, line 13; Fig. 6; and Fig. 7 (items 702, 704, 706, 708).

Consistent with the invention, as set forth in independent claim 25, a beauty diagnostic method is provided. The method involves receiving information regarding at least one external body condition of a subject (e.g., Figs. 9A, 9B, item 904) and, based on the received information, selecting from a plurality of testing materials, at least one customized set of testing material (e.g., Fig. 6: 602, 604, 606; Fig. 8: 800) for determining quantitative information that would aid in recommending at least one beauty product to the subject. The method also involves informing the subject (e.g., Figs. 9A, 9B, item 904) about said at least one customized set of testing material. See, e.g., Appellant's specification: page 35, line 13 – page 36, line 2.

Consistent with the invention, as set forth in dependent claim 26, a beauty diagnostic method is provided in which the information is chosen from answers to questions and at least one representation of the external body condition.

Consistent with the invention, as set forth in dependent claim 27, a beauty diagnostic method is provided in which the information is an image of the external body condition.

VI. Grounds of Rejection

The following grounds of rejection are to be reviewed:

A. Claims 1-10 and 24-30 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

B. Claims 1-25 and 28-30 stand rejected under 35 U.S.C. § 102(a) as anticipated by PCT International Publication No. WO 01/18674 A2 to *Maloney et al.* ("*Maloney*").

C. Claims 26 and 27 stand rejected under 35 U.S.C. § 103(a) as unpatentable over *Maloney* in view of U.S. Patent No. 6,293,284 to *Rigg* ("*Rigg*").

VII. Argument

Each claim of the present application is separately patentable, and upon issuance of a patent will be entitled to a separate presumption of validity under 35 U.S.C. § 282. The arguments set forth below are arranged under subheadings, and in accordance with 37 C.F.R. § 41.37(c)(1)(vii), these subheadings indicate the claims whose patentabilities are argued separately.

A. The rejection of claims 1-10 and 24-30 under 35 U.S.C. § 101 should be reversed because these claims define statutory subject matter.

According to the Examiner, claims 1-10 and 24-30 are “not within the technological arts” and are directed to “purely an abstract idea.” The § 101 rejection should be reversed because, contrary to the Examiner’s position, claims 1-10 and 24-30 are directed to statutory subject matter.

1. The Examiner’s “technological arts” analysis is not supported and fails to establish that claims 1-10 and 24-30 are non-statutory.

The Examiner’s so-called “technological arts” analysis is not supported by proper authority and fails to establish that claims 1-10 and 24-30 are non-statutory. The Examiner alleged that the claims “are completely silent with regard to technology and [are directed to] . . . purely an abstract idea or process steps that are employed without the use of any technology whatsoever.” Final Office Action at 4. In rejecting claims 1-10 and 24-30 under § 101, the Examiner alleged that the claims are directed to abstract ideas that “can be performed without interaction of a physical structure.” *Id.* at 5; *see also id.* at 8.

In a purported attempt to support the rejection, the Examiner cited *In re Toma*, 575 F.2d 872, 197 USPQ 852 (CCPA 1978). Final Office Action at 3. According to the Examiner, the court in *Toma* developed a “technological arts” analysis and found the claimed process at issue within the “technological art” because it was “an operation being performed by a computer within a computer.” *Id.* at 3-4. *In re Toma*, however, does not provide a basis for the Examiner’s “technological arts” analysis. Although the court in *Toma* recognized a “technological” or “useful” arts inquiry and found the claimed method at issue to be in the technological arts, the court rejected the “technological arts” rejection set forth by the Examiner in that case, explaining that the language in *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (1970), *In re Benson*, 441 F.2d 682, 169 USPQ 548 (1971), *Gottschalk v. Benson*, 409 US 63, 175 USPQ 673 (1972), and *In re McIlroy*, 442 F.2d 1397, 170 USPQ 31 (1971) regarding “mental steps” rejections “was not intended to create a generalized definition of statutory subject matter . . . [and] was not intended to form a basis for a new § 101 rejection.” *In re Toma*, 575 F.2d at 877-78, 197 USPQ at 857. Appellants submit that the Examiner has not provided from *Toma* a basis for the “technological arts” rejection of claims 1-10 and 24-30 set forth in the Final Office Action.

The Examiner also cited *In re Musgrave*, 431 F.2d 882, 167 USPQ 280 (CCPA 1970). Final Office Action at 2. The Examiner alleged that “the first test of whether an invention is eligible for a patent is to determine if the invention is within the ‘technological arts.’” *Id.* *In re Musgrave*, however, states that the presumption that the law “requires all steps of a statutory ‘process’ to be physical acts applied to physical things” is an “erroneous idea.” *In re Musgrave*, 431 F.2d at 892-93, 167 USPQ at 289.

The court noted that “it was a misconstruction to assume that ‘all processes, to be patentable, must operate physically upon substances.’” 431 F.2d at 893, 167 USPQ at 289. Additionally, the Federal Circuit has indicated that arguing that process claims are not patentable subject matter because they lack physical limitations “reflects a misunderstanding of...[the] case law.” *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359 (Fed. Cir. 1999) (emphasis added), 50 USPQ2d 1447, 1452-1453. Indeed, in *AT&T*, the claims at issue involved information exchange alone.

Even if, as the Examiner alleged, “the first test of whether an invention is eligible for a patent is to determine if the invention is within the ‘technological arts’” (to which Appellants do not acquiesce), the position that process claims are abstract and not within the technological arts because they “can be performed without interaction of a physical structure” is not supported by the relevant case law. Final Office Action at 2, 5, 8. For at least these reasons, the Examiner’s “technological arts” rejection of claims 1-10 and 24-30 set forth in the Final Office Action is improper and should be reversed.

The Examiner alleged that the decision in *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998) “never addressed the . . . ‘technological arts’ test established in *Toma* because the invention in *State Street* . . . was already determined to be within the technological arts under the *Toma* test.” Final Office Action at 4. The Examiner averred that the Board recognized this dichotomy in *Ex parte Bowman*, 61 USPQ2d 1669 (2001). *Id.*

As explained above, *In re Toma* makes clear that the language in the case law regarding mental steps and technological arts “was not intended to form a basis for a new § 101 rejection” *In re Toma*, 575 F.2d at 877-78, 197 USPQ at 857. Moreover, the

decision in *Ex parte Bowman* does not support the notion that determining the presence of an abstract idea, which was addressed in *State Street*, is a separate and distinct inquiry from determining whether a claimed invention is in the “technological arts.” In *Ex parte Bowman*, the Board interpreted the Examiner’s § 101 rejection in that case as “finding that the claimed invention . . . is nothing more than an abstract idea because it is not tied to any technological art or environment.” *Ex parte Bowman*, 61 USPQ2d at 1671 (emphasis added). The Board in *Ex parte Bowman* did not recognize the “technological arts” analysis as a distinct test, separate from the abstract idea inquiry, for determining whether a claim is directed to statutory subject matter. See *id.* Instead, the Board merely found that the claimed invention at issue was an abstract idea because it lacked connection to a technological art. In this case, Appellants submit that claims 1-10 and 24-30 are *not* abstract because, as explained in the following section of this brief, the claims include recitations that produce “concrete, tangible and useful” results. See *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1600-01; *AT&T Corp.*, 172 F.3d at 1358, 50 USPQ2d at 1451-52.

Furthermore, claims 1-10 and 24-30 are tied to a technological art. In *Ex parte Bowman*, the Board’s decision to affirm the § 101 rejection was based in part on the fact that neither the claims nor the specification discussed “the use of any technology with respect to the claimed invention.” *Ex parte Bowman*, 61 USPQ2d at 1671. The Board found that the invention was “not tied to any technological art . . . and [was] not a useful art” *Id.* The specification in this application, however, discusses several technological applications related to the claimed invention, thereby tying those claims to a technological art. See, for example, Appellants’ specification at pages 24-25; Fig. 2;

Fig. 7 and accompanying text; Figs. 9A, 9B and accompanying text; and pages 38-51.

The invention defined in claims 1-10 and 24-30 is therefore clearly tied to a technological art, and *Ex parte Bowman* does not support the Examiner's § 101 rejection.

The Examiner alleged that Appellants' claims "are employed . . . without the use of any technology whatsoever." Final Office Action at 4. The Examiner, however, does not articulate what subject matter would constitute "the use of . . . technology," and the case law cited by the Examiner makes clear that physical structures and computer-related limitations are not required for a claim to be statutory. Accordingly, the Examiner's allegation that the claims lack "the use of any technology whatsoever" is not properly supported and does not establish that Appellants' claims are non-statutory.

For at least the foregoing reasons, the Examiner's "technological arts" rejection of claims 1-10 and 24-30 is improper and should be reversed. As explained above, the Examiner's allegation that claims 1-10 and 24-30 are not within the technological arts because they "can be performed without interaction of a physical structure" is completely unsupported by legal precedent. The Examiner's conclusory allegation that the claims lack "the use of any technology whatsoever" is equally unsupported. Claims 1-10 and 24-30 are non-abstract and are tied to the useful or "technological" arts, regardless of whether they specifically recite "physical structure" or computer-related limitations. The Examiner's "technological arts" analysis is not supported by proper authority and fails establish that claims 1-10 and 24-30 are non-statutory.

2. Claims 1-10 and 24-30 are not abstract and are therefore statutory.

Contrary to the Examiner's position, claims 1-10 and 24-30 are not abstract. According to the Federal Circuit, the inquiry of whether a claim is statutory focuses on "the essential characteristics of the subject matter, in particular, its practical utility." *State Street*, 149 F.3d at 1375, 47 USPQ2d at 1602. If a claim includes recitations that produce "a concrete, tangible and useful result," the claim is not abstract and has practical utility. See *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1600-01; *AT&T Corp.*, 172 F.3d at 1358, 50 USPQ2d at 1451-52. And if the claim is not abstract and has practical utility, it is statutory under 35 U.S.C. § 101.

The Examiner's conclusory statement that the claims are directed to "purely an abstract idea" is unsupported and does not establish that the claims are in fact directed to an abstract idea. Claims 1-10 and 24-30 do in fact include recitations that produce "concrete, tangible and useful" results and, therefore, accomplish a practical application and are not abstract.

Claim 1 recites, *inter alia*:

based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject; and

informing the subject about said at least one customized set of testing material.

At least the above-noted features of claim 1 produce useful, concrete, and tangible results. For example, selecting a customized set of testing material is a useful, non-abstract result that facilitates a determination of quantitative information that would

aid in at least one beauty product recommendation. In addition, informing a subject about a customized set of testing materials is a useful, non-abstract result.

Moreover, as explained above, claims 1-10 and 24-30 are tied to the useful or “technological” arts, regardless of whether they specifically recite “physical structure” or computer-related limitations. Thus, even if the Examiner’s § 101 rejection is interpreted as finding that claims 1-10 and 24-30 are abstract because they are not tied to a technological art, the rejection should be reversed.

Independent claims 24 and 25, although each of different scope, are not abstract for at least reasons similar to those presented above in connection with claim 1. Further, claim 24 has a practical application in that “ascertaining ... desired quantitative information by collecting data derived from use of the testing material on the subject,” as recited in the claim, is a useful, non-abstract result that facilitates at least one beauty product recommendation. Claims 1-10 and 24-30 are drawn to useful, concrete, and tangible results, and are therefore not abstract but, rather, statutory under 35 U.S.C. § 101.

For at least the foregoing reasons, the rejection of claims 1-10 and 24-30 under 35 U.S.C. § 101 should be reversed.

B. The rejection of claims 1-25 and 28-30 under 35 U.S.C. § 102(a) based on *Maloney* should be reversed because *Maloney* does not anticipate those claims.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). A rejection under § 102 is proper only when the claimed subject

matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972). Further, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Finally, “[t]he elements must be arranged as required by the claim.” M.P.E.P § 2131; see *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, the rejection of claims 1-25 and 28-30 under 35 U.S.C. § 102(a) should be reversed because the Examiner has failed to establish that *Maloney* teaches each and every element of Appellant’s claimed invention, as discussed below.

1. Claims 1-10

The Examiner failed to establish that *Maloney* teaches each and every feature of claims 1-10. In particular, the Examiner failed to establish that *Maloney* teaches “based on ... received answers [to personal questions on at least one topic including characteristics of at least one external body condition of a subject], selecting from a plurality of testing materials ... at least one customized set of testing material,” as recited in claim 1 and required by dependent claims 2-10.

Maloney is directed to providing a customized product to a consumer (Abstract). Although *Maloney* describes obtaining personal information and providing a test kit to a consumer (p. 11, lines 7-9; 26-30), the reference does not teach that the test kit is selected from a plurality of testing materials or based on obtained personal information. *Maloney* merely mentions providing a test kit that “might comprise one or more tests” in order to collect “profiling data” about a consumer (p. 11, lines 6-7). Providing a consumer with a standard test kit in order to collect data about the consumer, as

described by *Maloney*, does not teach or suggest selecting a customized set of testing materials based on answers to personal questions, as recited in claim 1. Further, the mere fact that *Maloney* describes obtaining personal information does not signify the use of such information as a basis for selecting a customized set of testing material. In fact, *Maloney* describes (p. 11) that personal information is used to provide the user with a customized interface, not a customized set of testing material. For at least these reasons, *Maloney* does not teach the invention defined by claim 1.

Furthermore, even if all of the elements of independent claim 1 could be found in various teachings of *Maloney* – which is not the case – the reference does not clearly and unequivocally disclose the claimed invention or direct those skilled in the art to the claimed invention “without any need for picking, choosing, and combining various disclosures.” *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972) (emphasis added).

Because *Maloney* does not teach each and every element of claim 1, as a matter of law, it cannot anticipate that claim. As such, the rejection of claim 1 under 35 U.S.C. §102(a) based on *Maloney* should be reversed. The § 102(a) rejection of claims 2-10 should be reversed as well, at least because those claims depend upon claim 1 and include all of the features of claim 1.

2. Claims 11-19

The Examiner rejected independent claim 11 for reasons similar to those presented in the rejection of claim 1. Claim 11 recites, *inter alia*, “based on ... received answers [to personal questions on at least one topic including characteristics of at least one external body condition of a subject], selecting from a plurality of testing materials

... at least one customized set of testing material” For at least reasons similar to those presented above in connection with claim 1, *Maloney* does not teach at least the above-noted “selecting” features of claim 11.

Because *Maloney* does not teach each and every feature of claim 11, as a matter of law, it cannot anticipate that claim. The § 102(a) rejection of claim 11 based on *Maloney* should therefore be reversed. Additionally, the § 102(a) rejection of claims 12-19 should be reversed, at least because those claims depend upon claim 11 and therefore include all of the features of claim 11.

3. Claims 20-23

The Examiner rejected independent claim 20 for reasons similar to those presented in the rejection of claim 1. Claim 20 recites, *inter alia*, “based on ... received answers [to personal questions on at least one topic including characteristics of at least one external body condition of a subject], selecting from a plurality of testing materials ... at least one customized set of testing material” For at least reasons similar to those presented above in connection with claim 1, claim 20 is distinguishable from *Maloney*. Because *Maloney* does not teach each and every feature of claim 20, as a matter of law, it cannot anticipate that claim. The § 102(a) rejection of claim 20, and its dependent claims 21-23, based on *Maloney* should therefore be reversed.

4. Claim 24

The Examiner rejected independent claim 24 for reasons similar to those presented in the rejection of claim 1. Claim 24 recites, *inter alia*, “based on ... received answers [to personal questions on at least one topic including characteristics of at least one external body condition of a subject], selecting from a plurality of testing materials

... at least one customized set of testing material” For at least reasons similar to those presented above in connection with claim 1, claim 24 is distinguishable from *Maloney*. Because *Maloney* does not teach each and every feature of claim 24, as a matter of law, it cannot anticipate that claim. As such, the § 102(a) rejection of claim 24 based on *Maloney* cannot be sustained.

5. Claims 25 and 28-30

The Examiner rejected independent claim 25 for reasons similar to those presented in the rejection of claim 1. Claim 25 recites, *inter alia*, “based on . . . received information [regarding at least one external body condition of a subject], selecting from a plurality of testing materials . . . at least one customized set of testing material” For at least reasons similar to those presented above in connection with claim 1, *Maloney* does not teach at least the above-noted “selecting” features of claim 25. Because *Maloney* does not teach each and every feature of claim 25, as a matter of law, it cannot anticipate that claim. As such, the § 102(a) rejection of claim 25 based on *Maloney* should be reversed. The § 102(a) rejection of claims 28-30 should also be reversed, at least because those claims depend upon claim 25 and include all of the features of claim 25.

C. The rejection of claims 26 and 27 under 35 U.S.C. § 103(a) based on *Maloney* and *Rigg* should be reversed because a case for *prima facie* obviousness has not been established.

The rejection of claims 26 and 27 under 35 U.S.C. § 103(a) should be reversed because a case for *prima facie* obviousness has not been established with respect to those claims. To establish *prima facie* obviousness under 35 U.S.C. § 103(a), the Examiner must show first that the prior art references teach or suggest all the claim

limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Second, the Examiner must show that there is some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references in a manner resulting in the claimed invention. *In re Rouffet*, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). Third, the Examiner must show that there is a reasonable expectation of success to modify or combine. *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). Moreover, “[b]oth the suggestion and the reasonable expectation of success must be found in the prior art reference, not in the Applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

In this case, *prima facie* obviousness has not been established with respect to claims 26 and 27 at least because (1) neither *Maloney* nor *Rigg*, nor any combination thereof, teaches or suggests all of the features recited in claims 26 and 27; and (2) even if the supposed combination could yield all of the claimed elements – Appellants disputing that notion – the Examiner failed to provide a proper motivation to combine or modify *Maloney* and *Rigg* in a manner resulting in Appellants’ claimed invention.

1. Neither *Maloney* nor *Rigg*, nor any combination thereof, teaches or suggests each and every feature of claims 26 and 27.

Each of claims 26 and 27 depends from claim 25 and therefore includes all of the features recited in claim 25, including “based on ... received information [regarding at least one external body condition of a subject], selecting from a plurality of testing materials ... at least one customized set of testing material” For at least the reasons presented above in connection with claim 25, *Maloney* does not teach this

“selecting” feature. Furthermore, *Maloney* does not render the claimed “selecting” obvious.

The Examiner has not established that *Rigg* cures the deficiencies of *Maloney*. *Rigg* is directed to providing a virtual makeover (Abstract). The Examiner has not established that *Rigg* discloses or suggests “based on ... received information [regarding at least one external body condition of a subject], selecting from a plurality of testing materials ... at least one customized set of testing material . . .,” as recited in claim 25 and required by claims 26 and 27. Indeed, Appellants submit that *Rigg* fails to disclose or suggest the claimed “selecting.”

Because the Examiner failed to establish that the applied art discloses or suggests all of the features of claims 26 and 27, at least one of the essential criteria for establishing a *prima facie* case of obviousness is lacking. For at least this reason, the § 103(a) rejection of claims 26 and 27 based on *Maloney* and *Rigg* cannot be sustained.

2. The Examiner failed to establish that a skilled artisan would have combined *Maloney* and *Rigg* in a manner resulting in Appellants’ claimed combination.

Regardless of whether the features of claims 26 and 27 can be found in some combination of *Maloney* and *Rigg*, a case for *prima facie* obviousness has not been established with respect to these claims at least because the requisite motivation to combine the references is lacking.

Determinations of obviousness must be supported by evidence on the record. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001), 59 USPQ2d 1693, 1696-98 (finding that the factual determinations central to the issue of patentability, including conclusions of obviousness by the Board, must be supported by “substantial evidence”).

The desire to combine or modify references must be proved with “substantial evidence” that is a result of a “thorough and searching” factual inquiry. See *In re Lee*, 277 F.3d 1338, 1343-1344 (Fed. Cir. 2002), 61 USPQ2d 1430, 1433 (quoting *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52). Moreover, the Federal Circuit has clearly stated that the evidence of a motivation or suggestion to modify a reference must be “clear and particular.” *In re Dembicziak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Simply because references can be combined or modified does not render their combination obvious unless the references also suggest the desirability of the modification. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The Examiner can satisfy the burden of establishing a *prima facie* case of obviousness “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to [modify or] combine the relevant teachings of the references.” *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (citations omitted) (emphasis added). The Federal Circuit has reaffirmed the Examiner’s high burden associated with establishing a *prima facie* case of obviousness and has emphasized the requirement of specificity. See *In re Sang-Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

In this case, the Final Office Action does not show, by “clear and particular” evidence, that a skilled artisan considering *Maloney* and *Rigg*, and not having the benefit of Appellants’ disclosure, would have been motivated to combine or modify the references in a manner resulting in Appellants’ claimed invention. Instead, the Final Office Action merely identifies certain teachings of the cited references without

supplying a proper motivation for the alleged modification. The Examiner does not show that the cited art “suggests the desirability of the” combination, and no objective reason for combining or modifying the applied art to achieve the invention defined by claim 26 or claim 27 has been established.

The Examiner alleged that a skilled artisan would have modified *Maloney* in view of *Rigg* “because the digital scan would provide the most accurate determination of natural skin color, thereby resulting in consultant’s best recommendations.” Final Office Action at 8. These conclusory statements by the Examiner are not properly supported by facts on the record and do not evidence that a skilled artisan would have been motivated to combine or modify the references in a manner resulting in Applicants’ claimed combination. The Examiner failed to provide any evidence, beyond conjecture, to show that a digital scan would provide “the most accurate determination of natural skin color” or that an accurate determination of skin color would result in a “consultant’s best recommendations.” Indeed, the Examiner failed to show that either of the relied-upon references suggests combining their teachings.

Furthermore, as M.P.E.P. § 2141.02 articulates, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious (internal citations omitted). The Federal Circuit has opined that “virtually all [inventions] are combinations of old elements.” See *e.g.*, *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998) (citations omitted). The Federal Circuit has explained that an examiner may find every element of a claimed invention in the prior art but mere identification is not sufficient to negate

patentability. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). The court explained that “the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.” *Id.* In this case, the Examiner merely alleged that *Maloney* and *Rigg* disclose certain features without showing reasons that a skilled artisan would select or modify those elements in the manner claimed and without showing that the claimed invention as a whole would have been obvious.

Applicants submit that the conclusions in the Office Action were not reached based on facts gleaned from the cited reference and that, instead, teachings of the present application were improperly used to reconstruct the prior art. *Maloney* mentions providing a customized product to a consumer, and *Rigg* describes a virtual makeover. Neither of these references, however, teaches or suggests combining or modifying their respective teachings as alleged in the Office Action.

For at least the foregoing reasons, the required motivation to combine or modify the applied references is lacking. As such, *prima facie* obviousness has not been established with respect to claims 26 and 27 and the § 103(a) rejection of those claims should be reversed.

VIII. Conclusion

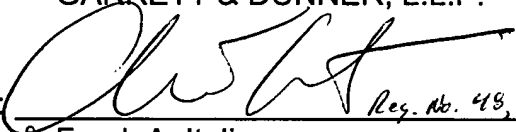
For the reasons given above, Appellants request that the Board of Patent Appeals and Interferences reverse the Examiner's rejections of pending claims 1-30 and place this application in condition for allowance.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 22, 2005

By:  *Reg. No. 48, 216*
Frank A. Italiano
Reg. No. 53,056

IX. Appendix A: Listing of Claims Under Rule 41.37(c)(1)(viii)

1. (Original) A beauty diagnostic method, comprising:
asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject;
receiving answers to the personal questions;
based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject; and
informing the subject about said at least one customized set of testing material.
2. (Original) The method of claim 1, further comprising providing the subject with the customized set of testing material.
3. (Original) The method of claim 1, further comprising providing the subject with a customized diagnostic kit containing the customized set of testing material.
4. (Original) The method of claim 1, further comprising ascertaining quantitative information by collecting data derived from use of the testing material on the subject.

5. (Original) The method of claim 4, further comprising recommending at least one beauty product to the subject based on the received answers and the ascertained quantitative information.

6. (Original) The method of claim 1, wherein the customized set of testing material includes at least one of a pH indicator, sebutape, and a corneodisque indicator.

7. (Original) The method of claim 2, wherein the questions are posed to the subject over a computer network, and wherein the at least one customized set of testing material is delivered to the subject via a courier.

8. (Original) The method of claim 2, further comprising maintaining an inventory of a plurality of differing groups of customized sets of testing material, each group containing a combination of testing material different from a combination in another group, and wherein providing the subject with a customized set includes selecting and shipping an appropriate set from a group maintained in inventory.

9. (Original) The method of claim 2, wherein providing the subject with the customized set includes providing the subject with material sufficient to conduct a single test.

10. (Original) The method of claim 2, wherein providing the customized set includes providing the subject with material sufficient to conduct multiple tests.

11. (Original) A beauty diagnostic system, comprising:
means for asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject;
means for receiving answers to the personal questions;
means for, based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject;
and
means for informing the subject about said at least one customized set of testing material.

12. (Original) The system of claim 11, further comprising means for providing the subject with the customized set of testing material.

13. (Original) The system of claim 11, further comprising means for ascertaining quantitative information by collecting data derived from use of the testing material on the subject.

14. (Original) The system of claim 13, further comprising means for, based on the received answers and the ascertained quantitative information, recommending at least one beauty product to the subject.

15. (Original) The system of claim 11, wherein the customized set of testing material includes at least one of a pH indicator, sebutape, and a corneodisque indicator.

16. (Original) The system of claim 12, wherein the questions are posed to the subject over a computer network, and wherein the at least one customized set of testing material is delivered to the subject via a courier.

17. (Original) The system of claim 12, further comprising means for maintaining an inventory of a plurality of differing groups of customized sets of testing material, each group containing a combination of testing material different from a combination in another group, wherein the means for providing the subject with at least one customized set of testing material includes means for selecting an appropriate group of sets maintained in inventory.

18. (Original) The system of claim 12, wherein the means for providing the subject with at least one customized set of testing material includes means for providing the subject with material sufficient to conduct a single test.

19. (Original) The system of claim 12, wherein the means for providing the subject with at least one customized set of testing material includes means for providing the subject with material sufficient to conduct multiple tests.

20. (Original) A computer program product for performing a beauty diagnostic, the computer program product comprising computer-readable media having computer-readable code, the computer program product comprising the following computer-readable program code for effecting actions in a computing platform:

program code for asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject;

program code for receiving answers to the personal questions;

program code for, based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject; and

program code for informing the subject about said at least one customized set of testing material.

21. (Original) The computer program product of claim 20, further comprising program code for providing the subject with at least one customized set of testing material.

22. (Original) The computer program product of claim 20, further comprising program code for ascertaining quantitative information by collecting data derived from use of the testing material on the subject.

23. (Original) The computer program product of claim 22, further comprising program code for, based on the received answers and the ascertained quantitative information, recommending at least one beauty product to the subject.

24. (Original) A beauty diagnostic method, comprising:
asking a subject personal questions on at least one topic including characteristics of at least one external body condition of the subject;
receiving answers to the personal questions;
based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject;
providing the subject with the customized set of testing material;
ascertaining the desired quantitative information by collecting data derived from use of the testing material on the subject; and
based on the received answers and the ascertained quantitative information, recommending at least one beauty product to the subject.

25. (Original) A beauty diagnostic method comprising:
receiving information regarding at least one external body condition of a subject;
based on the received information, selecting from a plurality of testing materials, at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject; and
informing the subject about said at least one customized set of testing material.

26. (Previously presented) The method of claim 25, wherein the information is chosen from answers to questions and at least one representation of the external body condition.

27. (Original) The method of claim 25, wherein the information is an image of the external body condition.

28. (Original) The method of claim 25, wherein the information is received via a network.

29. (Original) The method of claim 25, comprising providing the subject with the customized set of testing material.

30. (Original) The method of claim 25, wherein the customized set of testing material includes one of a pH indicator, sebutape, and a corneodisque indicator.

X. **Appendix B: Evidence Appendix to Appeal Brief Under Rule
41.37(c)(1)(ix)**

None.

XI. Appendix C: Related Proceedings Appendix to Appeal Brief Under Rule 41.37(c)(1)(x)

There are currently no other appeals or interferences, of which Appellants, Appellants' legal representative, or Assignee are aware, that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.